

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 1-12 and 19-28 are pending. No claims are amended or newly added.

In the outstanding Office Action, Claim 20 was rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Claim 21 was rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Claims 1-6, 11, 12, 19, 21-26, and 28 were rejected under 35 U.S.C. § 103(a) as obvious over Strang et al. (U.S. Patent No. 6,806,653, herein "Strang") in view of Serra (U.S. Patent No. 3,684,303, herein "Serra"). Claims 7-9 were rejected under 35 U.S.C. § 103(a) as obvious over Strang, Serra, and Dornfest (U.S. Patent No. 5,680,013, herein "Dornfest"). Claim 10 was rejected under 35 U.S.C. § 103(a) as obvious over Strang, Serra, and Moser (U.S. Patent No. 6,686,302, herein "Moser"). Claim 27 was rejected under 35 U.S.C. § 103(a) as obvious over Strang, Serra, and Foster (U.S. Patent No. 5,628,829, herein "Foster").

At the outset, Applicant notes with appreciation the courtesy of the personal interview granted by Primary Examiner Rudy Zervigon to Applicant's representative. In combination with the Interview Summary provided by Primary Examiner Zervigon, the substance of the interview is substantially summarized below in accordance with MPEP § 713.04.

Regarding the rejection of Claim 20 as failing to comply with the enablement requirement, as discussed in the personal interview, the term "blind hole" is a term of art, and a courtesy copy of an on-line glossary definition of "blind hole" is provided herewith. Accordingly, Applicant respectfully submits that the recitation of a "blind hole" in Claim 20 does not cause Claim 20 to fail to comply with the enablement requirement in 35 U.S.C. § 112, first paragraph.

Regarding the rejection of Claim 21 under 35 U.S.C. § 112, second paragraph, as indefinite, that rejection is respectfully traversed by the present response.

Applicant notes that the specification was amended in the previous response to refer to “at least one retaining ball 230.” Additionally, the first instance in which “a ball” is referred to in the claims is in dependent Claim 21. Accordingly, the term “a ball” does not lack antecedent basis, and Applicant respectfully submits that the rejection of dependent Claim 21 as indefinite is overcome for at least the reasons discussed above.

Regarding the rejection of Claims 1-6, 11, 12, 19, 21-26, and 28 as obvious over Strang in view of Serra, that rejection is respectfully traversed by the present response.

Applicant notes that the present application is based on provisional application Ser. No. 60/466,416, filed on April 30, 2003. As this filing date is earlier than the publication date of Strang, which is July 31, 2003, Strang, to the extent it qualifies as a reference, qualifies only under 35 U.S.C. § 102(e). Applicant further notes that the present application and Strang are commonly assigned and were commonly assigned at the time the claimed invention was made. A statement of common ownership is included on the following page. In accordance with MPEP § 706.02(1)(2).

STATEMENT CONCERNING COMMON OWNERSHIP

Applicant respectfully submits that the subject matter of Strang and the claimed subject matter of the present invention were, at the time the present invention was made, owned by the same person or subject to an obligation of assignment to the same person.

MPEP § 706.02(I)(2) states:

The following statement is sufficient evidence to establish common ownership of, or an obligation for assignment to, the same person(s) or organization(s):

Applicants and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time invention was made, if the applicant(s) or an attorney of agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.

See “Guidelines Setting Forth a Modified Policy Concerning the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 U.S.C. 103(c),” 1241 O.G. 96 (December 26, 2000).¹

¹ MPEP § 706.02(I)(2)II.

Accordingly, Applicant respectfully submits that, under the safe-haven provision in 35 U.S.C. § 103(c), Strang is disqualified as a reference in any rejection under 35 U.S.C. § 103, and the rejection of Claims 1-6, 11, 12, 19, 21-26, and 28 as obvious over Strang in view of Serra is overcome.

Regarding the rejection of Claims 7-9 as obvious over Strang, Serra and Dornfest, the rejection of Claim 10 as obvious over Strang, Serra, and Moser, and the rejection of Claim 27 as obvious over Strang, Serra, and Foster, Applicant respectfully submits that as Strang is disqualified as a reference in any obviousness rejection, each of the above-noted rejections is overcome.

Dependent Claim 26

Additionally, as discussed in the personal interview, dependent Claim 26 recites “wherein the boundary is a portion of a seam formed between the upper electrode and the lower electrode.” The boundary recited in dependent Claim 26 is first recited in dependent Claim 22, from which Claim 26 depends. Claim 22 recites “wherein a boundary of the recessed area is formed by a lower electrode formed separately from the inject plate.” One non-limiting example of the above-noted arrangement is shown in Fig. 2A. As discussed in the personal interview, the annular groove (26) described in Serra does not have a boundary formed by a seam of any kind, much less a seam formed by a lower electrode, which is formed separately from an inject plate, as recited in dependent Claim 26. Accordingly, Applicant respectfully submits that dependent Claim 26 patentably distinguishes over any reasonable combination of the cited references for at least the additional reasons discussed above.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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A hole made in a workpiece that does not pass through it.

See also: Drill Bits.



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